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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,091

Applicant(s)

SUZUKI, KOICHIRO

Examiner

LENNIN R. RODRIGUEZ

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-12, 19-22, 24-30, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 19-22, 24-30, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 5/4/2009 have been fully considered but they are not persuasive. Applicant's argument regarding "Mukai fails to disclose forming a database by storing, in the database, the ID information and page description language (PDL) data read from the recording medium, when printing is performed, and Teraura is silent on storing read ID information in association with other information when printing is performed, thereby to form a database to be referred to in copy processing" has been fully considered; in response Mukai '329 discloses database means (column 6, lines 56-58, database server) that, forms a database means, when an image relating to desired subject data is formed on a first recording medium in an image forming by the image forming means, stores first identification information, which is read by the detecting means from the first recording medium (column 6, line 52 through column 7, line 7, where the database stores information about the identification of the image data when the image is being printed), and the desired subject data in association with each other in the database (column 6, lines 52-62, printing data associated with the page ID); Mukai '329 discloses all the subject matter as described above except specifically teaching a recording medium having an RFID tag that stores information; However, Teraura '973 teaches a recording medium having an RFID tag that stores information (paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper and that the RFID also contains a memory to store

information); Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by Teraura '730 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the recording medium more efficient since it contains multiple information thus using less resources, having two means for storing ID and other data about a document makes the combination easily possible since it would be a matter of choice of technology to perform the same invention.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-4, 6-8, 10-12, 19-22, 24-26, 28-30 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukai (US 6,466,329) in view of Teraura (US 2002/01709730).

(1) regarding claims 1, 19 and 33:

Mukai '329 discloses an image forming system comprising:

image forming means that forms an image relating to subject data on a recording medium that stores identification information specific to the recording medium (column 4, lines 64-67 and column 5, lines 1-3, where the assigned page ID is printed on the page that would have the identification information);

detecting means that communicates with the recording medium and reads the identification information from the recording medium (column 6, lines 63-67, where the scanner detects the ID from the paper);

database means (column 6, lines 56-58, database server) that, forms a database means, when an image relating to desired subject data is formed on a first recording medium in an image forming by the image forming means, stores first identification information, which is read by the detecting means from the first recording medium (column 6, line 52 through column 7, line 7, where the database stores information about the identification of the image data when the image is being printed), and the desired subject data in association with each other in the database (column 6, lines 52-62, printing data associated with the page ID);

retrieving means (scanner 400 in Fig. 1) that retrieves subject data corresponding to the first identification information read by the detecting means from the first recording medium on which the image relating to the desired subject data is formed (column 10, lines 34-41, where the scanner identifies a page ID and retrieves its information from the database server), from plural subject data stored in the database means from plural subject data stored in the database means, at a timing different from the image forming operation for the image relating to the desired subject data on the first recording medium (column 10, lines 34-41, where the scanner retrieves its information from the database server); and

control means that controls, in accordance with a result of the retrieval by the retrieving means, the image forming means to form an image relating to the subject

data corresponding to the first identification information retrieved by the retrieving means on a second recording medium (column 10, lines 34-45, where the printing data retrieved is outputted to a printing device).

Mukai '329 discloses all the subject matter as described above except specifically teaching a recording medium having an RFID tag that stores information;

communicating with the RFID tag of the recording medium by a radio frequency communication and reading the identification information from the RFID tag; and

the image forming means to form an image on a second recording medium already having the RFID tag different from the first recording medium.

However, Teraura '973 teaches a recording medium having an RFID tag that stores information (paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper and that the RFID also contains a memory to store information);

communicating with the RFID tag of the recording medium by a radio frequency communication (paragraph [0060], lines 2-4) and reading information from the RFID tag (paragraph [0071], lines 3-6, reader-writer 15); and

the image forming means to form an image on a second recording medium already having the RFID tag different from the first recording medium (A3 in Fig. 6 and paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper, thus this sheet of paper can be substituted by the sheet of paper used to print in Mukai '329).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by Teraura '730 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the recording medium more efficient since it contains multiple information thus using less resources, having two means for storing ID and other data about a document makes the combination easily possible since it would be a matter of choice of technology to perform the same invention.

(2) regarding claims 2 and 20:

Mukai '329 further discloses selecting means that is capable of selecting the desired subject data from the plural subject data stored in the storing means (column 6, lines 65-67 and column 7, lines 1-7, where the information related to certain searched ID is retrieved).

(3) regarding claims 3, 7, 21 and 25:

Mukai '329 further discloses wherein at least a part of the image forming means, the detecting means, the storing means, the selecting means, the database means, and the retrieving means are connected via a network (column 6, lines 56-59).

(4) regarding claims 4 and 22:

Mukai '329 further discloses a detection unit in the vicinity of a moving path of the recording medium having in the image forming operation (page ID recognizer 71 in Fig. 1) and a recording medium brought close to the image forming means (column 10, lines

34-41, where a page is being brought to the scanner so that the ID information can be obtained).

Mukai '329 discloses all the subject matter as described above except wherein the detecting means includes a first detection unit for reading the information from the RFID tag of the recording medium in accordance with the image forming operation by the image forming means and a second detection unit for reading the information from the RFID tag of the recording medium at a timing different from the image forming operation by the image forming means, and

the first detection unit is provided in the vicinity of a moving path, and the second detection unit is provided at a position where the second detection unit can read out the identification information in the case where the recording medium is brought close.

However, Teraura '973 teaches wherein the detecting means includes a first detection unit for reading the information from the RFID tag of the recording medium in accordance with the image forming operation by the image forming means (paragraph [0072], where the reader-writer 15 reads information from the RFID tag) and a second detection unit for reading the information from the RFID tag of the recording medium at a timing different from the image forming operation by the image forming means (paragraph [0072], where the reader-writer 16 reads information from the RFID tag), and

the first detection unit is provided in the vicinity of a moving path (15 in Fig. 2), and the second detection unit is provided at a position where the second detection unit can read out the identification information in the case where the recording medium is

brought close (16 in Fig. 2, where the papers can be brought near the document discharger and the reader-writer is capable of reading the RFID tag).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have to detecting units for detection of identification information and that each of the detection devices are in different positions of the system as taught by Teraura '973 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the printer more efficient since it contains multiple places to perform the reading step thus making it user-friendlier.

(5) regarding claims 6 and 24:

Mukai '329 further discloses wherein the subject data includes image data (column 8, lines 57-61).

(6) regarding claims 8 and 26:

Mukai '329 further discloses wherein the database means further stores additional information, which is related to the image forming operation of the image of the subject data, in association with the subject data (column 6, lines 63-64 and column 7, lines 1-9, where the PDL data describes the original image, and the original image quality is ensured), and

the retrieving means retrieves the subject data corresponding to the additional information in the case where information identical with the additional information is inputted at a timing independent from the image forming operation (column 10, lines 34-

41, where the scanner identifies another page ID (second identification information) and retrieves its information from the database server and column 7, lines 3-7, where if the scanned image is found in the external storage, the image just captured is discarded and instead the saved one is retrieved).

(7) regarding claims 10, 28 and 34:

Mukai '329 further discloses wherein the database means further stores, in accordance with the image forming operation for the image of the retrieved subject data by the image forming means on the second recording medium, second identification information (column 10, lines 34-41, where the scanner identifies a page ID and retrieves its information from the database server), which is read by the detecting means from the second recording medium on which the image relating to the retrieved subject data is to be recorded (71 page ID recognizer Fig. 1), and the retrieved subject data in association with each other (column 10, lines 38-41, where the data retrieve is associated with the page ID).

Mukai '329 discloses all the subject matter as described above except specifically teaching reading information from the RFID tag;

However, Teraura '973 teaches reading information from the RFID tag (paragraph [0071], lines 3-6, reader-writer 15);

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by Teraura '730 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the

same medium or a combined medium (paragraph [0004]), making the recording medium more efficient since it contains multiple information thus using less resources.

(8) regarding claims 11 and 29:

Mukai '329 further discloses an image forming system (Fig. 1) comprising:

image forming means that forms an image relating to subject data on a recording medium that stores identification information specific to the recording medium (column 4, lines 64-67 and column 5, lines 1-3, where the assigned page ID is printed on the page that would have the identification information);

detecting means that communicates with a recording medium on which an image is formed by the image forming means (column 6, lines 63-67, where the scanner detects the ID from the paper); and

control means that retrieves subject data corresponding to the identification information read from a first recording medium on which an image corresponding to the subject data is formed by the image forming means (column 10, lines 34-45, where the printing data retrieved is outputted to a printing device), by the detecting means from plural subject data stored in a database that stores the identification information read from plural recording medium on which the images corresponding to the subject data is formed respectively (column 6, line 65 through column 7, line 7, where the database stores information about the identification of the image data) and the plural subject data in association with each other and controls the image forming means to form an image relating to the retrieved subject data on a second recording medium (column 10, lines

34-45, where the printing data retrieved is outputted to a printing device to be printed into another sheet of paper).

Mukai '329 discloses all the subject matter as described above except specifically teaching a recording medium having an RFID tag that stores information;

communicating with the RFID tag of the recording medium by a radio frequency communication and reading the identification information from the RFID tag; and

the image forming means to form an image on a second recording medium already having the RFID tag different from the first recording medium.

However, Teraura '973 teaches a recording medium having an RFID tag that stores information (paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper and that the RFID also contains a memory to store information);

communicating with the RFID tag of the recording medium by a radio frequency communication (paragraph [0060], lines 2-4) and reading information from the RFID tag (paragraph [0071], lines 3-6, reader-writer 15); and

the image forming means to form an image on a second recording medium already having the RFID tag different from the first recording medium (A3 in Fig. 6 and paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper, thus this sheet of paper can be substituted by the sheet of paper used to print in Mukai '329).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by

Teraura '730 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the recording medium more efficient since it contains multiple information thus using less resources.

(9) regarding claims 12 and 30:

Mukai '329 further discloses wherein the control means includes retrieving means that retrieves the subject data corresponding to the identification information, which is detected by the detecting means, from plural subject data stored in storing means (column 10, lines 34-41, where the scanner identifies a page ID and retrieves its information from the database server).

4. Claims 9 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukai (US 6,466,329) and Teraura (US 2002/01709730) as applied to claims above, and further in view of Bontempi (US 2003/0137689).

(1) regarding claims 9 and 27:

Mukai '329 and Teraura '973 disclose all the subject matter as described above except wherein the additional information includes identification information of an apparatus and application software which executed the image forming operation for the image of the subject data.

However, Bontempi '689 teaches wherein the additional information includes identification information of an apparatus and application software which executed the image forming operation for the image of the subject data (paragraph [0033], where the

information received includes printer identification field and a printer driver which executed the image forming operation).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the additional information includes identification information of an apparatus and application software which executed the image forming operation for the image of the subject data as taught by Bontempi '689 in the system of Mukai '329 and Teraura '973. This enhances the capabilities of the system by allowing it to specify which printer and which software to use for the creation of the image print out.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is

(571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Lennin R Rodriguez/
Examiner, Art Unit 2625